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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,602	04/18/2001	John H.J. Petrini	800.019US2	3378

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EXAMINER

YU, MISOOK

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 08/21/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/837,602

Applicant(s)

PETRINI ET AL.

Examiner

MISOOK YU, Ph.D.

Art Unit

1642

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 June 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): Written description rejection.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 4,20 and 21.Claim(s) objected to: 2 and 24-27.Claim(s) rejected: 1,22,23 and 28.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Misook Yu, 8-13-2003

Continuation of 5. does NOT place the application in condition for allowance because:

At the outset, the Office note a typographical error; the art rejection is under 102 (a) instead of 102 (b). Upon reconsideration, claim 20 is interpreted as drawn to an isolated nucleic acid molecule encoding the full length protein, therefore the rejection of claim 20 under 35 102 (a) is withdrawn.

Claims 1, 22, 23 and 28 remain rejected for reason of record under 35 U.S.C. 102(a) as being anticipated by either NCBI accession number AA577530 (Sept. 03, 1997) or NCBI accession number AA535711 (Aug. 21, 1997). Applicant argues that the art of record is EST sequences with high quality sequences stop at certain positions, does not teach an isolated and purified nucleic acid encoding biological fragment having DNA repair activity or fusion protein or DNA repair polypeptide which binds an antibody specific for SEQ ID NO:2. These and other argument have been fully considered but found not persuasive because the two EST sequences are inserted in two purified and isolated vectors and the inserted sequences encode C-terminal part of the protein encoded by fragment of instant SEQ ID NO:1. Any antibody capable of binding SEQ ID NO:2 would be able to bind the C-terminal part of the same protein encoded by the prior art. As previously stated, the Office does not have facility to conduct experiment whether the C-terminal fragments encoded by the prior art have the recited activity or not, and the Office could not determine whether the prior art is excluded from the claimed invention since the specification does not teach which part of the protein has the recited activity. Applicant is invited to present scientific data that the prior art is excluded from the claimed invention to obviate this rejection.

Mary Mosher
MARY E. MOSHER
PRIMARY EXAMINER
GROUP 1400 1600